REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-18 are pending.

In the Official Action, Claims 1, 3-7, 9-13, and 15-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hitachi Koki Imaging Solutions, Inc. document entitled "The Internet Docket Controller" dated October 2000 (hereinafter Hitachi); and Claims 2, 8 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hitachi.

Briefly recapitulating, Claim 1 is directed to a method of monitoring an image forming apparatus. The method includes: a) receiving, at a location which is remote from the image forming apparatus, first parameters representing a condition of at least one part of the image forming apparatus; b) storing the first parameters; and c) receiving, at the location which is remote from the image forming apparatus, second parameters after at least one image forming operation is executed by the image forming apparatus. The second parameters represent the condition of the at least one part of the image forming apparatus related to at least one of the first parameters. The method also includes d) comparing, at the location which is remote from the image forming apparatus, the received first parameters and second parameters; and e) controlling a display of the condition on a terminal that is remote from the image forming apparatus using a result of the comparing step. Applicants' claimed invention allows for improved remote control over printing resources.

Hitachi describes Internet-enabled copiers and printers which allow access to product information, device configuration, local and remote printing, finishing, service and support from a standard web browser. Hitachi further describes i-copiers and i-printers which incorporate Hitachi's Internet Document Controller™ (iDoc) architecture for device control and monitoring via web-based device management software. The Hitachi architecture

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includes printer emulations which facilitate document reproduction for users working in a variety of software or hardware environments (e.g., PCL 5e, PCL 6 and TIFF, with Adobe® PostScript® 3). The Hitachi architecture enables a single printer to offer up to 64 print services, or "virtual printers," each of which can be individually configured to address environments that do not rely on print drivers, such as UNIX.

Hitachi also describes an *i-billing* module used to calculate usage information, to apply the usage information to a service plan and to print a monthly invoice. From an embedded web page a consumer and a dealer can see actual toner usage on a job-by-job basis, or on a monthly or quarterly timeframe. The *i-copier/printer* is able to adjust a monthly invoice based on actual toner usage above or below a contracted allowance. Hitachi also describes an ability to email monthly "click counts" for copy and print jobs.

Hitachi describes an *i-print* module for printing/distributing documents locally, remotely and globally via one of four printing methods. The four methods are:

- **network printing** to a single print engine on a local network;
- **broadcast printing** to multiple engines of the same or different types on a network;
- **printing** to a single printer anywhere in the world, using the IPP protocol; and
- **broadcast printing** to multiple local and remote engines, over a network and/or the Internet using the IPP protocol.

Hitachi also describes bi-directional print drivers having a graphical user interface and two-way communication with a printer or copier. The driver-integrated Printer Monitor is a Windows-based utility that displays a printer's capabilities and status so a user can know available media types and sizes and a printer setup before printing. The Printer Monitor window displays the messages shown on the copier/printer's Operator Control Panel, a list of outstanding jobs, printer status that might affect a print job, such as Printer Offline or Door Open, and provides automatic event notification such as Toner Low or Paper Out. Every user on the network can individually configure the Printer Monitor for the specific events they

want to be notified about and the way they want to be notified – via pop-up message, beep or other sound. The Printer Monitor can tell a user when the last page of a job has printed.

The Official Action refers to the Hitachi *i-service* module frequently. The *i-service* module enables technicians, using a standard web browser, to access service documentation, remotely configure a copier/printer and run *remote* diagnostics for subsystem components via the Internet or a modem. Service logs for accounting data such as clock counts, events like Toner Low, and copier/printer errors, can be downloaded on demand or emailed at specified times. The Hitachi *i-service* module allows a remotely located technician to access a machine and make a number of electromechanical adjustments. The Hitachi *i-service* module allows a remotely located technician to program the copier/printer to send error reports and early warning notifications for preventative maintenance and consumables replenishment by email or page without user interaction.

The Official Action mischaracterizes Hitachi. That is, the description of the *i-service* module relied upon in the Official Action is clear that there is no comparing of received parameters in the *i-service* module. This module allows a technician at a remote site to cause a diagnostic routine to run at the printer. That is, the parameters that relate to the diagnostic are compared at the printer, with a final diagnostic result forwarded to the remote site. That is, the "*remote* diagnostics for subsystem components" are remote to the technician, and are not remote to the printer.

Furthermore, the Official Action asserts that Applicants' comparing first and second parameters is inherent in Hitachi. A proper showing of inherency is based on the fact "that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art"[1] Here, the Official Action provides inadequate rationale for any finding of inherency.

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[1]See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," (emphasis in original). See also In re Robertson, 49 USPQ2d 1949, 1951 (Fed.

That is, page 6 of the Official Action states that the Hitachi triggering of a "maintenance warning" message at a certain number (first parameter) of pages inherently requires that an actual number of pages have been printed (second parameter) be received by the remote device management arrangement, and compared to the number (first parameter) to trigger the "maintenance warning" message. Applicants traverse this characterization. The control window shown page 4 of Hitachi shows that the number of pages that triggers the maintenance warning *is set at the remote location*. In the exemplary control window, a value of 390 is shown in a drop-down box. This drop down box allows an operator *at the remote location* to set the number (first parameter) that triggers the "maintenance warning" message. Thus, the number (first parameter) that triggers the "maintenance warning" message in Hitachi is not received at a location which is remote from the image forming apparatus. Instead, it appears this first parameter is generated at the remote location.

Furthermore, while Hitachi does not explain how the number (first parameter) that triggers the "maintenance warning" message is used, it appears that the control window shown page 4 of Hitachi is used to allow user of a remote terminal to control when the printer will send the maintenance warning message. Thus, any comparing of actual pages printed to a predetermined number is performed at the printer, and not at the remote (i.e. technician's) location.

"The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic."[2] "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary

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Cir. 1999) ("[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,'" citing Continental Can Co. v. Monsanto Co., 948 F2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient," Id. at 1269 (citation omitted)).
[2] *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993).

skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."[3] In view of the figures on page 4 of Hitachi, Applicants' claimed feature not inherent in Hitachi. In fact, Hitachi teaches away from Applicants' claimed invention because Hitachi compares at the printer a first parameter to a remotely set parameter, rather than comparing two separately received parameters at a location remote to the printer.

MPEP § 2131 notes that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Hitachi does not disclose or suggest all the features recited in Claims 1, 7 and 13, Hitachi does not anticipate the invention recited in Claims 1, 7 and 13, and all claims depending therefrom.

Accordingly, in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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[3] *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).